

REMARKS/ARGUMENTS

Entry of the foregoing and further consideration of the subject application in light of the remarks that follow and consistent with 37 C.F.R. 1.111 are respectfully requested.

Upon entry of the above amendment, claims 1-18 and 21 will have been cancelled. Claims 22-23 are new. Support for new claims 22 - 23 can be found on Page 15, Line 36 to Page 16 Line 11, and claims 20 - 21. Accordingly, claims 19-20 and 22-23 will remain pending in the application with claims 19 and 22 being independent.

Drawings

Figure 1 has been amended with a legend "Prior Art" as suggested in the office action in compliance with 37 CFR 1.121(d).

Withdrawal of this rejection is respectfully requested.

Specification

The specification is amended with a reference on page 1 of the patent application. Withdrawal of this rejection is respectfully requested.

Claim Rejections - 35 USC § 112

Claim 21 has been cancelled.

Withdrawal of this rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 103

In the Office Action, claims 19-20 are rejected under 35 U.S.C. § 103(a) as being obvious over admitted prior art in view of Deckman et al. (US 5,716,527) or Haag et al. (US 5,110,478). The office action states that it would be obvious to one having ordinary skill in the art at the time the invention was made to have modified the admitted prior art apparatus by including a zeolite

membrane unit as suggested by either Deckman or Haag because including such a unit would provide for additional separation of the desired product thereby improving the efficiency of the process that utilizes the apparatus. Applicants respectfully disagree.

Applicant's invention relates to a paraxylene recovery plant comprising:

- (a) paraxylene recovery unit; and
- (b) a zeolite membrane unit comprising a zeolite membrane and optionally isomerization catalyst.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

To find obviousness, "there must be some reason for the combination other than the hind sight gleaned from the invention itself." *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985). Stated in another way, "[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch* 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992).

Neither Deckman or Haag explicitly or implicitly suggests combining the membrane disclosed in either Deckman or Haag for a paraxylene recovery plant. The only way to make the combination cited in the Office Action is by using the Applicant's disclosure. Such a combination based upon the applicant's disclosure would constitute an impermissible use of hindsight.

For the foregoing reasons, Applicants respectfully request that the Examiner withdraw the rejection.

CONCLUSION

It is respectfully submitted that all claims 19-20 and 22-23 are in condition for allowance and favorable action thereon is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees that are required or credit any overpayment to Deposit Account No. 05-1712. A duplicate copy of this page is attached hereto.

Respectfully submitted,

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